The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper ~~139~~ 6

By: Trial Section Merits Panel
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UNITED STATES PATENT AND TRADEMARK OFFICE
(Administrative Patent Judge Carol A. Spiegel)

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

GARY H. RASMUSSON and GLENN F. REYNOLDS

Junior Party,
Application 08/460,296

v.

SMITHKLINE BEECHAM CORPORATION

Senior Party,
U.S. Patent 5,637,310
U.S. Patent 5,496,556
Reissue Application 09/964,383
Reissue Application 09/984,083

Patent Interference 104,646

Before: SCHAFER, TORCZON and SPIEGEL, Administrative Patent Judges.

SPIEGEL, Administrative Patent Judge.

ORDER VACATING O.C. and ENTERING FINAL JUDGMENT
(37 CFR § 1.658)

A. Conference calls

Two telephone conference calls have been held as a result of the ORDER TO SHOW CAUSE ("O.C.," Paper 138) which issued September 24, 2003.

1. September 30, 2003

A first telephone conference was held on September 30, 2003 at approximately 1:50 p.m., involving:

1. Richard E. Schafer and Carol A. Spiegel, Administrative Patent Judges.
2. Herbert H. Mintz, Esq. and Lara C. Kelley, Esq., counsel for SMITHKLINE BEECHAM CORPORATION (SKB).
3. Daniel S. Glueck, Esq., counsel for RASMUSSON.

The primary purpose of the conference call was to discuss Rasmusson's position vis-a-vis the O.C. (Paper 138). Rasmusson has had the opportunity to and did (a) file preliminary and miscellaneous motions, (b) take testimony in regard thereto, (c) have a hearing on said motions and (d) receive a MEMORANDUM OPINION and ORDER ("Decision," Paper 122) thereon. Rasmusson also had the opportunity to and did (d) request reconsideration of the Order and (e) receive a decision thereon (see DECISION ON RECONSIDERATION and ERRATA (Papers 135 and 136). As confirmed by Mr. Glueck, Rasmusson has chosen not to assert a priority contest. When asked if there was any other matter necessary to decide before proceeding to final judgment, Mr. Glueck replied that Rasmusson could not think of anything else but requested until 12:00 p.m. on October 3, 2003 to bring any unresolved matter to the Board's attention.[1]

In short, there appeared to be no reason to continue the interference proceeding since Rasmusson has chosen not to present evidence on the issue of priority or derivation and Rasmusson has already taken testimony and had a hearing on motions and has received both a decision on motions and a reconsideration thereof by a three-

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[1] According to the O.C. (Paper 138, p. 2), Rasmusson was ordered to "notify the Board of any other matter necessary to resolve the interference within **ten (10) days** of the filing of this order by filing a brief for final hearing in accordance with 37 CFR § 1.656" and to make "any request for a final hearing ... within **ten (10) days** of the filing of this order.

judge panel. It was proposed that the O.C. be vacated, that the Decision and the Decision on Reconsideration be merged into a final judgment and that the hearing on motions be deemed to be a final hearing for purposes of this interference proceeding. It was agreed that a final judgment would issue on October 3, 2003 unless Rasmusson brought any other unresolved matter to the Board's attention via a conference call before 12:00 p.m. on October 3, 2003.

2. October 3, 2003

A second telephone conference call was held on October 3, 2003 at approximately 11:00 a.m., involving:

1. Carol A. Spiegel, Administrative Patent Judge.
2. Herbert H. Mintz, Esq. and Lara C. Kelley, Esq., counsel for SKB.
3. Robert L. Baechtold, Esq. and Daniel S. Glueck, Esq., counsel for Rasmusson. Mr. Haiyan Chen was also present for Rasmusson.

According to Mr. Glueck, the aforementioned proposal was unacceptable to Rasmusson because it felt required to file a final brief and request a final hearing in order to have a "final" decision from the Board for purposes of appeal. Rasmusson stated that it would brief and argue the same issues it had raised in RASMUSSON REQUEST FOR RECONSIDERATION (Paper 127) for "final hearing," in particular the granting of SKB preliminary motion 3 which stripped Rasmusson of the priority benefit of its eight earlier filed applications. In other words, as pointed out by Mr. Mintz, no new issues or arguments would be briefed and argued that had not already been briefed and argued. SKB wondered what justification there was for expending any additional time, effort and money on what has already been decided ("heard") and reconsidered ("reheard"). Neither Rasmusson nor SKB took any position as to priority. The sole concern was whether any judgment which issued after vacating the O.C. could be considered a "final" judgment.

B. This judgment is "final" appealable decision

1. finality is determined pragmatically

Finality is required for judicial review. Barton v. Adang, 162 F.3d 1140, 1143, 49 USPQ2d 1128, 1131 (Fed. Cir. 1998). "For purposes of review, an agency action is final if it (1) represents 'a terminal, complete resolution of the case before the agency,' ... and (2) "determine[s] rights or obligations, or ha[s] some legal consequence" (Capital Network System, Inc. v. F.C.C., 3 F.3d 1526, 1530 (C.A.D.C. 1993) (citations omitted). "To determine whether an agency action is to be deemed 'final' for purposes of judicial review, we look 'in a pragmatic way' to whether the challenged agency action is 'definitive' and to whether it has a 'direct and immediate ... effect on the day-to-day business' of the challenger." Chicago Truck Drivers, Helpers and Warehouse Workers Union (Independent) v. National Mediation Bd., 670 F.2d 665, 668 (C.A. 7 (Ill.) 1981) (citations omitted).

As set forth in Hells Canyon Preservation Council v. Richmond, 841 F.Supp. 1039 (D.Or. 1993):

> [t]he "finality" requirement mandates that a plaintiff identify a "final agency action" and is designed to (1) avoid premature interruption of the administrative process; (2) let the agency develop the necessary factual background upon which decisions should be based; (3) permit the agency to exercise its discretion or apply its expertise; (4) improve the efficiency of the administrative process; (5) conserve scarce judicial resources, since the plaintiff may be successful in vindicating rights in the administrative process and the courts may never have to intervene; (6) give the agency a chance to discover and correct its own errors; and (7) avoid the possibility that flouting of administrative processes could weaken the effectiveness of an agency by encouraging people to ignore its procedures. United States Postal Service v. Notestine, 857 F.2d 989, 993 (5th Cir. 1988) (citations omitted).

2. this action is final for purposes of judicial review

According to 37 CFR § 1.654, "parties will be given an opportunity to appear before the Board to present oral argument at a final hearing" "[a]t an appropriate stage

of the interference." 37 CFR § 1.655 addresses the matters to be considered in rendering a final decision, and reads, in relevant part,

> (a) [i]n rendering a final decision, the Board may consider any properly raised issue, including priority of invention, derivation by an opponent who filed a preliminary statement under § 1.625, patentability of the invention, admissibility of evidence, any interlocutory matter deferred to final hearing, and any other matter necessary to resolve the interference. The Board may also consider whether an interlocutory order should be modified. ... .

a. Rasmusson has chosen not to assert a priority or derivation challenge

The fundamental purpose of an interference is to determine priority. 35 U.S.C. § 102(g). Rasmusson has chosen not to assert a priority or derivation challenge.[2]

b. interlocutory matters have been heard, decided and the decision reconsidered for possible modification

Rasmusson and SKB have received a decision on their remaining preliminary and miscellaneous motions following oral argument by a three judge panel (Paper 122).[3] No motions have been deferred. Under current practice, three judge panel decisions bind further action during the interference proceeding.[4] Cf. 35 U.S.C.

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[2] Rasmusson did not serve evidence on the issue of priority or derivation by time period 2, September 8, 2003 (Paper 132, p. 3). Rasmusson's counsel has confirmed at least twice that Rasmusson will not be filing such evidence (see telephone conferences of September 30 and October 3, 2003).

[3] SKB preliminary motion 1 and miscellaneous motion 1 were denied (Papers 29 and 100, respectively). Rasmusson miscellaneous motions 2 and 3 were denied (Paper 60).

[4] According to the STANDING ORDER governing proceedings before the Trial Section (in relevant part),

> **20. Decisions**
> **20.1 Three-judge decisions govern further proceedings**
> An interlocutory order (37 CFR § 1.601(q)) entered by a panel consisting of three or more administrative patent judges generally governs further proceedings in an interference.
> **20.2. Request for reconsideration**
> **20.2.1** Reconsideration of interlocutory orders
> A party may request reconsideration of any interlocutory order (37 CFR § 1.640(c)).
> A party may request review at final hearing of any interlocutory order (37 CFR §

§ 6(b) (patentability and priority determined by panels of at least three). Rasmusson promptly sought reconsideration of the decision (Paper 127). SKB's views on Rasmusson's request for reconsideration were also "heard" (Paper 133). A decision on reconsideration was issued (Papers 135 and 136).

c. no other issues necessary to resolve the interference exist

Neither Rasmusson nor SKB have been able to identify any other issue which remains to be resolved in this interference.

d. under these circumstances, this action is final for purposes of judicial review

To the extent that current practice may be interpreted as requiring a final hearing with briefing for purposes of "finality," we deem the hearing on motions to be that "final hearing" and note that matters to be addressed at final hearing (37 CFR § 1.658(a)) have been addressed already. Therefore, we merge our prior decisions on motions (Papers 29, 60, 100, 122, 135 and 136) into a "final" decision.

The proceeding is not being prematurely interrupted. Rather, termination of the interference at this point is consistent with securing "the just, speedy, and inexpensive determination" of the interference by avoiding needlessly subjecting the parties to redundant and unnecessary expenditures of time, effort and money. 37 CFR § 1.601. Indeed, there are no issues remaining for us to decide. In other words, the necessary factual background has been fully developed and the Board has exercised its discretion and applied its expertise. Going forward with a final briefing and final hearing where nothing new is being added and priority is not being determined does not improve the efficiency of the administrative process and needlessly expends the resources of the parties and the Board. Moreover, Rasmusson's request for reconsideration has

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1.655(a)), but the panel that will conduct the review generally will be the same panel that entered the interlocutory order even if other issues at final hearing are determined by a separate panel. Accordingly, the most efficient way to seek review of an interlocutory order entered by a panel is through a request for reconsideration.

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20.2.2 Number of requests

No more than one request for reconsideration may be filed per party per board decision.

presented the Board with the chance to discover and correct its own errors. Finally, there is no apparent denial of due process since all issues fairly presented and fully briefed have been decided by a three judge panel after oral hearing on the merits followed by reconsideration of the initial decision.

3. this action is without prejudice to either party requesting a final hearing in the event of remand or reversal by our reviewing court

In the event that a reviewing court reverses and/or remands the merger of our decision on motions and reconsideration thereof into a final action, the parties will not be deemed to have waived their right to a final hearing in accordance with 37 CFR §§ 1.654-1.656. Further, insofar as SKB has taken no position on priority, SKB is deemed not to have waived its right to testimony on the issue of priority.

C. Order

Therefore, in order to secure the just, speedy and inexpensive determination of interference, it is

ORDERED that the ORDER TO SHOW CAUSE issued September 24, 2003 (Paper 138) is vacated.

FURTHER ORDERED that all of the initial decisions on motions, i.e., MEMORANDUM OPINION and ORDER (Papers 29, 60, 100 and 122), DECISION ON RECONSIDERATION (Paper 135) and ERRATA (Paper 136) are merged into this FINAL JUDGMENT.

FURTHER ORDERED that judgment on priority as to Count 2, the sole count in the interference (Paper 123), is awarded against junior party Rasmusson, i.e., GARY H. RASMUSSON and GLENN F. REYNOLDS.

FURTHER ORDERED that junior party Rasmusson, i.e., GARY H. RASMUSSON and GLENN F. REYNOLDS, is not entitled to a patent containing claims 1-8 (corresponding to Count 2) of application 08/460,296, filed June 2, 1995.

FURTHER ORDERED that a copy of this paper shall be made of record in the files of Rasmusson application 08/460,296, of SKB reissue applications 09/964,383 and 09/984,083 and U.S. Patents 5,637,310 and 5,496,556 issued to SKB.

FURTHER ORDERED that if there is a settlement agreement which has not been filed, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661.

RICHARD E. SCHAFER)
Administrative Patent Judge)
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RICHARD TORCZON) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
)
CAROL A. SPIEGEL)
Administrative Patent Judge)

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INTERFERENCE DIGEST

Interference No. 104,646 Paper No. 5

Name: Randall K. Johnson

Serial No.: 09/964,383 Patent No.

Title: Method of treating prostatic adenocarcinoma

Filed: 09/28/01

Interference with Rasmusson et al.

DECISION ON MOTIONS

Administrative Patent Judge,_____ Dated,_____

FINAL DECISION

Board of Patent Appeals and Interferences, [signature] Dated, 15-8-03

Court,_____ Dated,_____

REMARKS

This should be placed in each application or patent involved in interference in addition to the interference letters.